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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/329,391
Filing Date: June 10, 1999
Appellant(s): SOEPENBERG ET AL.

MAILED
OCT 23 2007
GROUP 2600

Larry Liberchuk
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/22/07 and amended on 8/22/07 appealing from the Office action mailed 1/24/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal 2004-0849 on Application 09/329,391, mailed to Appellant on September 30 2004.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,420,866	WASILEWSKI	5-1995
5,734,589	KOSTRESKI	3-1998
5,614,940	COBBLEY	3-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not provide sufficient details to enable a skilled in the art to make and use the invention because it does not adequately describe the following:

Regarding claim 12, how to insert/extract information into/from userInfo field of a DSM-CC DownloadInfoIndication message, as the message structure, generation and destination are not properly disclosed.

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The specification does not provide enough details about the structure and operation of the elements associated with the above identified claimed features to enable one skilled in the art to make and use the invention without undue experimentation.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Claims 7 and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claimed signal is not directed to one of the four types of statutory subject matter: a process, a machine, manufacture or composition of matter.

See Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, page 57. OG notice, 22 Nov. 2005.

Claim Rejections - 35 USC § 103

3. Claims 1-8, 10, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski (US 5,420,866) in view of Kostreski (US 5,734,589).

4. Regarding claims 1, 3, 5 and 7 Wasilewski substantially teaches the limitations of the claims:

a transmission system (transmission system, as shown on Fig. 2) for transmitting a multiplex signal 68 (shown on Fig. 4) from a transmitter 8 (satellite uplink) to a receiver 201(subscriber location, see col. 8 lines 1-30). Multiplex signal 68 carries Program Map Table (PMT) to each decoder (see col. 10 lines 8-30). Signal 68 has at least a module 72 (Program

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Definition 2 on Fig. 4) comprising at least one object 80 (Elementary Stream Definition 2 on Fig. 4).

Receiver 201 (shown on Fig. 6 and described on col. 13 lines 35-68) has extracting means (decoder 110) for extracting objects 80 from the multiplex signal 68. Decoder 110 is adapted to extract objects 80 (Elementary Stream Definition 2, Fig. 4) based on the module 72 (Program Definition 2, Fig. 4) related information 74 (Program Number, Fig. 4). Module related information 74 is included in the multiplex signal 68 (see Fig. 4).

Wasilewski does not teach using a carousel having a plurality of modules and the objects including executable code.

Kostreski teaches using a data carousel to create a customized program guide for users, as disclosed on col. 5, line 55 through col. 6 line 6, and downloading to the customer terminal an executable software/code to provide the customer with new services, as disclosed on col. 4 lines 39-66.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add using a data carousel and the objects including executable code of Kostreski to the system of Wasilewski to improve the system operation for the users by creating customized program guides and add new services to produce video/audio information outputs to the customer actions.

5. Regarding claims 2, 4, 6 and 8 Wasilewski discloses a transmission system (see rejection of claims 1, 3, 5 and 7 above) where module related information (Program Definition 2 on Fig. 4) is contained in a single information section (Program Number 74 on Fig. 4) of the transport stream 68.

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6. Regarding claims 10, 11 and 13, Wasilewski in view of Kostreski substantially teaches the limitations of the claim (see claim 1 rejection above).

Wasilewski does not teach modules to include a pre-fetch tag for information extraction and extraction means.

Kostreski teaches tags to identify user selected broadcast channels and download/pre-fetch the available channels, as disclosed on col. 5 line 32-54, extracting them from the broadcast stream and inherently using extraction means to extract the pre-fetch tags, because the extraction means are essential for the system operation.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add pre-fetch tag for information extraction, including the extraction means, of Kostreski to the system of Wasilewski to improve the system operation by making all selected channel information available for the user.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski in view of Kostreski in further view of Cobbley (US 5,614,940).

Wasilewski in view of Kostreski substantially teaches the limitations of the claim (see claims 1 and 13 rejections above).

Wasilewski in view of Kostreski does not teach modules to include versions and the receiver does not pre-fetch modules when the modules with the same versions are already stored in the receiver.

Cobbley teaches the modules comprise versions to identify old and new versions of the broadcasted programs and terminating the delivery of the old version when the new is available, col. 9, lines 20-45.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add modules to include versions and the receiver does not pre-fetch modules when the modules with the same versions are already stored in the receiver of Cobbley to the system of Wasilewski in view of Kostreski to improve the system operation by delivering the latest version of the broadcast program to the user.

(10) Response to Argument

On pages 6-8 of the Brief, Appellant argues that claim 12 cannot be rejected under 35 U.S.C. 112, first paragraph, because it is supported by the specification.

Examiner respectfully disagrees.

Examiner clearly identified the pertinent portions of the claimed material which are not supported by the disclosure.

A DSM-CC DownloadInfoIndication message, as disclosed in the Appellant cited portion of the disclosure (6:29-7:2) does not describe the message structure, generation and destination and does not teach how to insert/extract information into/from userInfo field of a DSM-CC DownloadInfoIndication message, as the message structure, generation and destination are not properly disclosed

Therefore, the specification does not provide enough details about the structure and operation of the elements associated with the above identified claimed features to enable one skilled in the art to make and use the invention without undue experimentation

Appellant failed to provide a copy of "MPEG-2 digital storage media command and control" of July 1996.

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The copy of this document was requested by the Examiner under rule 37 CFR 1.105 on 7/31/07.

Instead of the copy of the standard, dated July 1996, Appellant filed a copy of the standard, dated 1998-09-01.

As the effective filing date of the current application is 06/12/1998, the provided copy of the standard cannot be used by the Appellant, as the standard did not exist at the effective filing date of the application.

Therefore the limitations of claim 12, directed to DSM-CC DownloadInfoIndication message are not supported by the disclosure or any applicable standard.

On pages 8-10 of the Brief, Appellant argues that amended claims 7 and 8 limitations are statutory.

Examiner respectfully disagrees.

Claim 7 limitations are directed to a signal, as computer readable medium is a portion of the claim preamble, because the computer readable media is not referred in the body of the claim.

Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, clearly identify signal as nonstatutory subject, see pages 55-57.

On pages 10-14 of the Brief, Appellant argues that there is no motivation to combine Wasilewski and Kostreski references.

Examiner respectfully disagrees.

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The Supreme Court opinion in KSR case (04-1350, U.S. Apr. 30, 2007), rejected the rigid application of the test, requiring “teaching, suggesting or motivation” in the prior art which would lead one of the ordinary skills in the art to combine the prior art teachings.

In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, both teaching are clearly belong to analogous art, as they are directed to a digital multimedia broadcast system, distributing video and audio programs to the customers. In addition to the program delivery teaching of Wasilewski, Kostreski teaches using a carousel 5:60-6:6 and downloading executable code/software to control the customer interaction with the service provider to provide different services 4:39-67.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add using a data carousel and the objects including executable code of Kostreski to the system of Wasilewski to improve the system operation for the users by creating customized program guides and add new services to produce video/audio information outputs to the customer actions.

In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

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combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding Appellants arguments directed to the limitations of claim 1, Wasilewski teaches a plurality of modules, each comprising at least one object, and Kostreski teaches a data carousel to create a customized program guide for users and downloading to the customer terminal an executable software to provide the customer with new services. See claim 1 rejection above for details.

On page 14 of the Brief, Appellant argues that Wasilewski does not teach claim 2 limitation, directed to “the module related information is contained in a single information section”.

Examiner respectfully disagrees.

Wasilewski clearly teaches the module related information is contained in a single information section as a Program Definition 2, shown on Fig. 2 which is contained in a single information section of Program Number field 74 on Fig. 4.

Appellant arguments are irrelevant as they are directed to a subject matter which was not directly claimed.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Dmitry Levitan

Primary Examiner

10/16/07



**DMITRY LEVITAN
PRIMARY EXAMINER**

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